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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,457	12/27/2001	Dennis E. Smith	82987AEK	8364

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EXAMINER	
AUGHENBAUGH, WALTER	
ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/033,457

Applicant(s)

SMITH ET AL.

Examiner

Walter B Aughenbaugh

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED February 24, 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

### **ADVISORY ACTION**

1. The Request for Reconsideration filed February 24, 2005 has been received and considered by Examiner.

### ***REPEATED REJECTIONS***

2. The 35 U.S.C. 103(a) rejection of claims 1, 2, 5, 7, 9-19, 21, 22, 24-26 and 28-39 that was repeated in paragraph 4 of the previous Office Action mailed January 31, 2005 has been repeated for the reasons previously made of record.

3. The 35 U.S.C. 103(a) rejection of claims 8 and 27 that was repeated in paragraph 5 of the previous Office Action mailed January 31, 2005 has been repeated for the reasons previously made of record.

4. The 35 U.S.C. 103(a) rejection of claim 40 that was repeated in paragraph 6 of the previous Office Action mailed January 31, 2005 has been repeated for the reasons previously made of record.

5. The 35 U.S.C. 103(a) rejection of claims 42 and 43 that was repeated in paragraph 7 of the previous Office Action mailed January 31, 2005 has been repeated for the reasons previously made of record.

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

6. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of claims 1, 2, 5, 7, 9-19, 21, 22, 24-26 and 28-39 over Maier et al. in view of Narita et al. presented on pages 2-4 of the Request for Reconsideration have been fully considered but are not persuasive.

Applicant argues that Maier et al. "fails to teach or disclose thermal stability as compared to other styrenic materials", but the claims do not require that the microbeads be thermally stable

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“as compared to other styrenic materials”. Applicant addresses the Office’s citation of col. 3, lines 9-12 of Maier et al. by stating that “[c]ellulose esters have poor thermal stability”, but col. 3, lines 9-12 states “... when compared with the prior art, especially the cellulose esters”; cellulose esters are not the sole prior art polymer. Applicant states that “[t]here is no specific teaching or suggestion that the materials of Maier et al. have a 2% weight loss above 270°C”, but it is stated in paragraph 10 of the Office Action mailed March 29, 2004:

The recitation “experiencing a 2% weight loss above 270°C” defines thermally stable as experiencing a weight loss of less than 2% at temperatures below 270°C; since Maier et al. teach the shaped article comprising the microbeads as claimed by Applicant having the same composition as that claimed by Applicant, the microbeads of Maier et al. are necessarily thermally stable as Applicant has defined thermally stable.

Applicant argues that “Narita et al. does not teach, disclose or suggest that inclusion of any colorant modifies the properties of the polymeric layer into which the colorant is added”, but, as stated in paragraph 10 of the Office Action mailed March 29, 2004, Narita et al. disclose that by appropriately incorporating coloring materials such as pigments, dyes and fluorescent whitening agents into the dye receptor layer, the desired color is produced to match the color of the corresponding printing paper (col. 10, lines 36-44) and that the b\* value indicates the degree of yellowness (col. 10, lines 45-62); Narita et al. therefore clearly teach that the inclusion of colorants “modifies the properties of the polymeric layer into which the colorant is added” (i.e. inclusion of colorants modifies the degree of yellowness as indicated by the b\* value). The dye receptor layer of Narita et al. is a polymeric layer (col. 9, lines 12-15 and 21-29), if Applicant intends to indicate that the dye receptor layer is not polymeric with the underlining of “of the polymeric layer”.

Applicant argues that “there is no teaching in Narita et al. of adding pigments or colorants to a microbead”, but the microbeads of Maier et al., the primary reference, are microbeads of

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acrylates (i.e. polyacrylates) as made of record in previous Office Actions, and Narita et al. teach that an exemplary polymeric material of the layer in which coloring material is incorporated (i.e. the dye receptor layer) is a polyacrylate resin (or styrene/acrylic copolymer resin, col. 9, lines 21-29), so one of ordinary skill in the art would have recognized to have modified, e.g., the polyacrylate of the microbeads of Maier et al. as proposed in previous Office Actions since Narita et al. teaches that the coloring material is incorporated in a polyacrylate resin. Applicant argues that “[p]igmented or colored microbeads of Maier et al. would still undergo a yellowing over time when exposed to UV light”, but there is no requirement in the claims that the change in b\* limitation remain “over time”. All of the limitations of the claims are met for the reasons discussed above.

7. Applicant’s arguments regarding the 35 U.S.C. 103(a) rejections of claims 8, 27 and 40 presented on page 4 of the Request for Reconsideration have been fully considered but are not persuasive. Applicant’s arguments depend entirely upon Applicant’s arguments regarding the 35 U.S.C. 103(a) rejection of claims 1, 2, 5, 7, 9-19, 21, 22, 24-26 and 28-39 over Maier et al. in view of Narita et al. presented on pages 2-4 of the Request for Reconsideration, which have been addressed above.

8. Applicant’s arguments regarding the 35 U.S.C. 103(a) rejection of claims 42 and 43 over Maier et al. in view of Harrison et al. and in further view of Narita et al. presented on pages 4-5 of the Request for Reconsideration have been fully considered but are not persuasive.

Applicant argues that “pigmented or colored microbeads of Maier et al. would still undergo a yellowing over time when exposed to UV light”, but there is no requirement in the claims that the change in b\* limitation remain “over time”. Applicant argues that not all of the

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limitations of claim 42 are taught by the cited references, but note that it is stated in paragraph 10 of the Office Action mailed March 29, 2004 that

The recitation "experiencing a 2% weight loss above 270°C" defines thermally stable as experiencing a weight loss of less than 2% at temperatures below 270°C; since Maier et al. teach the shaped article comprising the microbeads as claimed by Applicant having the same composition as that claimed by Applicant, the microbeads of Maier et al. are necessarily thermally stable as Applicant has defined thermally stable.

Applicant argues that Harrison et al. "does not disclose or suggest that the microbeads have [the claimed change in  $b^*$  value]", but the Office Action mailed August 4, 2004 does not state that Harrison et al. does disclose or suggest this. Narita et al. is relied upon to address the claimed change in  $b^*$ .

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

03/08/05

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

3/8/05